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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,211	07/07/2003	Harsch Khandelwal	1028-023US01	8049
28863	7590	11/18/2005	EXAMINER	
SHUMAKER & SIEFFERT, P. A. 8425 SEASONS PARKWAY SUITE 105 ST. PAUL, MN 55125			SUN, SCOTT C	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,211	KHANDELWAL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Scott Sun	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 July 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/25/2005; 12/8/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 6, 8, 10-13, 17, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claims 5, 13, and 17, the use of terms "enable" and "can" are indefinite because they fail to specify applicant's intended metes and bounds since the claims seem to cover anything and everything that does not prevent actions from occurring. The limitations using these terms do not cause any functionality in the system. It is suggested that the reclaims are rephrased without the above terms so a definitive action is described. For example, limitation in claim 5 can be rephrased to "... capture device is a portable wireless device"; similarly limitation in claim 13 can be rephrased to "... an electronic marketing engine utilizing the captured data for electronic marketing"; and claim 17 can be "... the system functionality is enhanced by uploading one or more global rules into said system". For the purpose of continuing prosecution, a prior art is interpreted to read on the above limitations if the prior art discloses physical element but does not explicitly disclose the inability for the physical element to carry out the functions. For example, regarding claim 5, if prior art disclose "a system according to claim 1, wherein at least one capture device is a wireless device" without explicit mention to enabling operator mobility, it would still read on the entirety of claim 5.

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4. Regarding claims 8, 10, 11, and 12, the use of relative terms "efficiently" and "quick" which render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purpose of continuing prosecution, these terms will simply be ignored from ascertaining the scope and meaning of the claims. It is suggested that the applicant remove the use of these terms in the claims.

5. Regarding claim 22, "security rounds data" has no antecedent basis in the specification. For the purpose of continuing prosecution, "security rounds data" will be interpreted as "security data".

6. Regarding claim 6, it is rejected because of its dependency on claim 5.

7. The following rejections are made based on the examiner's best interpretation of the claims in light of the 35 USC 112 rejections above.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-8, 11-15, 17-19, 21, 22, 24, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (PG Pub #2001/0016819).

10. Regarding claim 1, 24, and 25, Kolls discloses a system/method/means for the capture, storage, and manipulation of remote information, the system (universal interactive advertising and payment system, disclosed in paragraphs 44, 45) comprising: at least one remote information capture device (system 500 in figure 3A-3F, figure 4) located at a remote site for capturing remote data (paragraphs 54, 55, 62); The examiner notes that system 500 is the hardware portion of the universal interactive advertising and payment system disclosed by Kolls. The examinee interprets the cell phone in figure 3F, an embodiment of Kolls's system 500, fitting the limitation of "located at a remote site for capturing remote data" because a cell phone communicates with its server from a remote location, and hence the data the phone captures from its user and transfers to the server are also remote data. Kolls further discloses a central data base accessible by the remote capture device for storing the captured remote data (figure 5, server, paragraph 120); Kolls further discloses a computer program operative to manipulate the captured data (universal interactive advertising and payment system disclosed by Kolls includes a computer program, paragraphs 44,45). The examiner further asserts that for the system disclosed by Kolls to perform the disclosed functions (capturing, processing, storing electronic data) a computer program is required.

11. Regarding claim 2, Kolls discloses the system according to claim 1, wherein the remote information is patron data (paragraphs 45, 120, and throughout reference). The examiner asserts that credit card, customer identification, and any other information

gathered by the system from a user of the system for the purpose of conducting e-commerce as disclosed by Kolls qualifies as patron data. Refer to Kolls's background section for a detailed overview of e-commerce at the time of Koll's invention.

12. Regarding claim 3, Kolls discloses the system according to claim 1, wherein at least one capture devices includes a bar code reader (figure 4, bar code reader).
13. Regarding claim 4, see examiner's argument for claim 2 above.
14. Regarding claim 5, Kolls discloses the system according to claim 1, wherein at least one capture device is a wireless device to enable operator mobility (figure 3F, see examiner's remarks for claim 1 regarding the cell phone system disclosed by Kolls).
15. Regarding claim 6, see examiner's argument for claim 2 above.
16. Regarding claim 7, Kolls discloses the system according to claim 1, wherein at least one of the remote capture devices is a wireless LAN or WAN-enabled (figure 4, LAN network connection means) unit for communicating with the central database in real time (paragraphs 66-67). The examiner asserts that communications over a network such as LAN or WAN are performed with no perceptible delay, and thus are real time. Furthermore, since applicant's disclosure does not mention a novel or unique form of LAN or WAN, it is assumed that they are functionality equivalent to a typical LAN or WAN like those disclosed by Kolls.
17. Regarding claim 8, Kolls discloses the system according to claim 7, further including a verifier for efficiently verifying captured data (paragraphs 45, 70).

18. Regarding claim 11, Kolls discloses the system according to claim 7, further including an efficient signature capturerer for reducing overhead when capturing patron signatures (figure 4, element 534; paragraph 83).

19. Regarding claim 12, Kolls discloses the system according to claim 7, wherein at least one capture device includes a magnetic stripe reader to efficiently capture patron information (figure 4, element 550).

20. Regarding claim 13, Kolls discloses the system according to claim 7, further including an electronic marketing engine to enable electronic marketing utilizing the captured data (paragraph 116, 138)

21. Regarding claim 14, Kolls discloses the system according to claim 7, further including patron interface for patron participation (figure 4, keypad, display means, camera, speakers are all patron interfaces for patron to interact with the system).

22. Regarding claim 15, Kolls discloses the system according to claim 7, wherein the system further includes a fraudulent use detector (figure 4, alarm, paragraph 78)

23. Regarding claim 17, Kolls discloses the system according to claim 7, wherein the system can be uploaded with one or more global rules (paragraph 68, program code, service data, transaction data).

24. Regarding claim 18, Kolls discloses the system according to claim 7, further including means for driving customers to a website utilizing captured data (background). Kolls describes prior art which utilizes PC to conduct e-commerce by browsing webpages, which fits the description of claim 18, since a user of PC enters information

into the PC to be directed to a website. Some well-known examples of such systems are Ebay and Amazon.

25. Regarding claim 19, Kolls discloses the system according to claim 7, further including an incorporator for incorporating captured data within a multimedia presentation (figure 4, video/audio record and playback means). The examiner asserts playback of a video (along with sound) is a multimedia presentation.

26. Regarding claim 21, Kolls discloses the system according to claim 7, further including a digital camera for capturing patron photos (figure 4, camera).

27. Regarding claim 22, Kolls discloses the system according to claim 1, wherein the remote information is security rounds data (paragraph 78).

#### ***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 9, 10, 16, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (PG Pub #2001/0016819), and further in view of Winters (PG Pub 2001/0034635).

31. Regarding claim 9, Kolls discloses claim 7 but does not disclose explicitly rewards. However, Winters discloses a global rules manager (website in figure 1B) for managing flexible rewards (LEDOs described throughout the reference) in varying degrees of granularity down to a patron-specific level (figure 1B, paragraph 43- 46, 59). The examiner asserts that by browsing the website disclosed by Winters and managing LEDOs using web pages on the website provides varying degrees of granularity because a website is a series of linked webpages (through use of hyperlinks, buttons, shortcut icons) which vary in degree of detail. For example, a home page is less detailed than other webpages on the website. Furthermore, teachings of Winters and Kolls are from the same field of electronic commerce.

Therefore, it would have been obvious at the time of invention to combine Winters's teachings with Kolls's teachings by implementing a similar website as disclosed by Winters, or providing a link to LEDOs website disclosed by Winters (after registering with LEDOs website, see paragraph 14, Winters) in the system disclosed by Kolls for the benefit of attracting and retaining customers (paragraph 12, Winters)

32. Regarding claim 16, Winters further discloses an electronic contest generator (paragraph 40, instant-win, lottery, redemption points)

33. Regarding claim 10, Kolls discloses claim 7 but does not explicitly teach an Internet address generator. However, the examiner asserts that generating user information such as email addresses to match a user name is well known in the art of e-commerce. An example is given by Winters (paragraph 73) in which user information can be automatically filled in for the user. Therefore it would have been obvious to

incorporate this feature into the system disclosed by Kolls for the benefit of providing convenience to the user.

34. Regarding claim 20, Kolls discloses claim 7, but does not explicitly teach a privacy consent selector. However, the examiner asserts that such privacy consent selector for capturing patron approval is well known in the art of e-commerce. Therefore, it would have been obvious to implement a privacy consent selector in Kolls's invention to get patron approval before the user enters sensitive/personal information.

35. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls (PG Pub #2001/0016819), and further in view of Sugar et al (PG Pub 2002/0029164).

36. Kolls discloses claim 1 but does not teach explicitly capturing parking data remotely. However, Sugar combined with Kolls discloses the system according to claim 1, wherein the remote information is parking data (paragraph 27. Furthermore, teachings of Sugar and Kolls are from the same field of e-commerce.

Therefore it would have been obvious at the time of invention to combine Sugar's invention with Kolls's invention by adding the website features to reserve and pay for parking disclosed by Sugar into the system disclosed by Kolls for the benefit of reducing cost in handling parking operations.

***Conclusion***

37. Other publications are cited to further show the state of the art with respect to electronic commerce systems. Refer to form 892, "Notice of References Cited", for a complete list of relevant prior arts cited by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Sun whose telephone number is (571) 272-2675. The examiner can normally be reached on M-F, 10:30am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS – 11/9/2005

  
KIM HUYNH  
PRIMARY EXAMINER

11/14/05